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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,695	02/22/2002	James F. McGuckin JR.	1917	1281

7590

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EXAMINER

DESANTO, MATTHEW F

ART UNIT

PAPER NUMBER

3763

DATE MAILED: 08/27/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/081,695

Applicant(s)

MCGUCKIN ET AL.

Examiner

Matthew F DeSanto

Art Unit

3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,5,8. 6) ☐ Other:

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 4, 5, 6, 7, 8, 9, 12, 13, 14, and 27 rejected under 35 U.S.C. 102(b) as being anticipated by Hofling (USPN 5,419,777).

Hofling discloses a surgical apparatus surgical apparatus for delivering fluid to treat a lesion comprising an elongated member having a distal tip and a plurality of openings formed in a sidewall proximal of the distal tip; a plurality of fluid delivery members movably positioned in the elongated member, each of the fluid delivery members having a lumen and at least one opening communicating with the lumen for delivering fluid to the lesion; and an actuator operatively associated with the fluid delivery members, the actuator actuable to a first position to move the fluid delivery members from a retracted position within the elongated member to a first deployed position extending radially with respect to the elongated member and actuable to a second position to move the fluid delivery members from the first deployed position to a second deployed position extending further radially from the elongated member, the

fluid delivery members being retained in the first and second deployed positions by a retention member (See Figures 1, 2, 3, 4, 5, 7 and entire reference).

3. Claims 1 – 14, and 27 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Edwards et al. (USPN 6,129,726).

Edwards et al. discloses a surgical apparatus surgical apparatus for delivering fluid to treat a lesion comprising an elongated member having a distal tip and a plurality of openings formed in a sidewall proximal of the distal tip; a plurality of fluid delivery members movably positioned in the elongated member, each of the fluid delivery members having a lumen and at least one opening communicating with the lumen for delivering fluid to the lesion; and an actuator operatively associated with the fluid delivery members, the actuator actuable to a first position to move the fluid delivery members from a retracted position within the elongated member to a first deployed position extending radially with respect to the elongated member and actuable to a second position to move the fluid delivery members from the first deployed position to a second deployed position extending further radially from the elongated member, the fluid delivery members being retained in the first and second deployed positions by a retention member (See Figures 4-10, 13-38 and entire reference).

4. Claims 1-9, 12-14 and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by McGuckin et al. (USPN 6,425,887).

McGuckin et al. discloses a surgical apparatus surgical apparatus for delivering fluid to treat a lesion comprising an elongated member having a distal tip and a plurality of openings formed in a sidewall proximal of the distal tip; a plurality of fluid delivery

members movably positioned in the elongated member, each of the fluid delivery members having a lumen and at least one opening communicating with the lumen for delivering fluid to the lesion; and an actuator operatively associated with the fluid delivery members, the actuator actuable to a first position to move the fluid delivery members from a retracted position within the elongated member to a first deployed position extending radially with respect to the elongated member and actuable to a second position to move the fluid delivery members from the first deployed position to a second deployed position extending further radially from the elongated member, the fluid delivery members being retained in the first and second deployed positions by a retention member (See Figures 3-22 and entire reference)

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-14, 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGuckin et al. as applied to claim 1 above, and further in view of Foster (USPN 6,217,559).

McGuckin et al discloses the claimed invention except for the retention member comprising a tab mounted on the actuator in one of the plurality of recesses formed in the housing.

Foster teaches a tab mounted on the actuator in one of the plurality of recesses formed in the housing (See Figure 1-4 and entire reference)

At the time of the invention it would have been obvious for one of ordinary skill in the art to combine the device of McGuckin with the teachings of the locking device of Foster because Foster teaches an efficient and effective locking mechanism on a surgical device which allows for the "needle" to be maintain in a deployed position and then released when necessary. (Foster Columns 1 and 2)

### ***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-14 and 27 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the copending Application No. 10/074468. Although the conflicting claims are not identical,

they are not patentably distinct from each other because they claim similar structure such as an actuator, pluralities of needles, and retention member.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew F DeSanto whose telephone number is 1-703-305-3292. The examiner can normally be reached on Monday-Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 1-703-308-3552. The fax phone numbers for the organization where this application or proceeding is assigned are 1-703-872-9302 for regular communications and 1-703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 1-703-308-0858.



Matthew DeSanto  
Art Unit 3763  
August 21, 2003



MICHAEL J. HAYES  
PRIMARY EXAMINER